13/ Petition under 1.181 c/m 3-19-01

Beiersdorf 576-KGB
6713-Dr. Wi-ar

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Bet 3-28-01

APPLICANTS	:	RAINER KROPKE ET AL.
SERIAL NO.	:	09/376,794
FILED	:	August 18, 1999
FOR	:	COSMETIC AND DERMATOLOGICAL PREPARATIONS WITH A CONTENT OF CHITOSAN AND PHOSPHOLIPIDS
ART UNIT	:	1615
EXAMINER	:	G. Kishore

March 19, 2001

Box AF
Hon. Commissioner of Patents
Washington, D.C. 20231

PETITION TO WITHDRAW PREMATURE FINAL REJECTION

SIR:

Applicants respectfully request that the Commissioner exercise his authority and withdraw the finality of the Office Action dated October 17, 2000, which is believed to be premature.

No fee is believed to be due for consideration of this petition. However, should the Commissioner determine that a fee is, in fact, due, he is hereby authorized to charge such fee to Deposit Account No. 14-1263.

The facts in support of this petition are as follows: A request was made in the paragraphs bridging pages 2-3 of the amendment dated February 20, 2001, that the finality of the Office Action dated October 17, 2000, be withdrawn. On page 2 of the Office Action, the claims are rejected for the first time under 35 USC § 112, second paragraph, as being indefinite in their use of the term "tackiness." On page 5 of the Office Action, a statement is made that the new grounds of rejection in the Office Action were necessitated by Applicants' amendment. However, since original claim 2 used the word "tackiness" in the next-to-last line thereof, it is clear that this rejection could have been raised against original claim 2 in the first Office Action, but wasn't. Consequently, the Examiner's position that Applicants' last amendment necessitated this new rejection is simply untenable.

That same paragraph also contained the following statement:

> "In view of the foregoing, Applicants request that the Examiner withdraw the finality of the open Office Action. *In the event that a formal petition is necessary to accomplish this result, then Applicants respectfully request that this be considered a petition.* No additional fee is believed to be due in connection with such petition, but, if it is, then the Commissioner is hereby authorized to charge such fee to Deposit Account No. 14-1263."

In response, the Examiner has now issued the Advisory Action dated March 8, 2001, which does not remove the finality of the last Office Action, and which also does not treat Applicants' previous request as a petition. Accordingly, this petition is now renewed.

The Examiner writes in the Advisory Action that:

> "The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because the originally presented claim 2 uses the word 'non-tackiness' meaning no tackiness at all; instant claim recites 'reducing the tackiness' which is different. Therefore, it is reasonable to question as to how much is the reduction."

In response, and for the Commissioner's convenience, original claim 2 is reproduced below:

– –2. Use of combinations of

(a) chitosan having an average molecular weight of from 10,000 to 2,000,000 g/mol and a degree of deacylation of from 10 to 99% and

(b) one or more phospholipids for the preparation of *non-tacky* cosmetic preparations, in particular O/W emulsions, or for <u>*reducing the tackiness*</u> of cosmetic preparations, in particular O/W emulsions. – –

Clearly, although the Examiner is correct that claim 2 recited the term "non-tacky," *claim 2 also recited the phrase "for reducing the tackiness."* Accordingly, the inclusion of the phrase "for reducing the tackiness" in claim 4 submitted in the amendment dated August 9, 2000, could not have raised for the first time the rejection of this phrase, which the Examiner said in the final rejection dated October 17, 2000, was necessitated by Applicants' amendment. Clearly, Applicants' amendment did not necessitate such rejection, as the phrase was present in original claim 2, which was not rejected on that ground. Accordingly, between the time the Examiner issued the first Office Action and the time he issued the final rejection, the Examiner *changed his mind about the propriety of the phrase and rejected it.* However, such change in position is a new rejection not necessitated by Applicants' amendment, and, therefore, the final rejection, which contained such new ground of rejection, should not have been made final.

According to MPEP § 706.07(a):

> "Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement * * *."

Clearly, the issuance of such a new ground of rejection precluded the Examiner from

making final the Office Action dated October 17, 2000. Accordingly, Applicants respectfully request that the Commissioner exercise his authority and remove the finality of the Office Action dated October 17, 2000.

The need for this action can clearly be gleaned from the Advisory Action dated March 8, 2001, as the Examiner makes no response whatsoever to numerous points raised by Applicants in the amendment dated February 20, 2001. Accordingly, this action is seen partly as necessary to get a detailed notice of the defects in Applicants' previous arguments.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Petition to Withdraw Premature Final Rejection is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: March 19, 2001 By _____
Kurt G. Briscoe